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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/049,284 | 06/17/2002 | Jacqueline Marchand | DCLERC 1 | 9585 |

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MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

EXAMINER

SMALL, ANDREA D SOUZA

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|-----------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/049,284 | MARCHAND ET AL. |
| | Examiner | Art Unit |
| | Andrea D Small | 1626 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 February 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 6-35 is/are pending in the application.
 - 4a) Of the above claim(s) 10-20 and 22-25 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 6-9,21 and 26-35 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) Interview Summary (PTO-413) Paper No(s). _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

I. Preliminary Amendment:

- (a) Preliminary amendment filed 2/11/2003 has been received and entered as paper no. 10.
- (b) Claims 1-5 have been cancelled.
- (c) Claims 6, 7, 9, 21, 26 and 28-30 have been amended.
- (d) Claims 31-35 have been newly added.
- (e) Pending claims: 6-35.

II. Election/Restriction:

The election/restriction outlined in office action of paper no. 7 has been withdrawn in view of the office action that appears below.

Restriction is required under 35 U.S.C. 372:

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 6-9, 21, 26-35, drawn to compounds of claim 35.

Group II, claim(s) 10-13, drawn to first intermediate of claim 13.

Group III, claim(s) 14-17, drawn to second intermediate of claim 14.

Group IV, claim(s) 18-20, drawn to third intermediate of claim 18.

Group V, claim(s) 22 and 25, drawn to a process of employing intermediates 1, 2 and 3.

Group VI, claim(s) 23 and 24, drawn to a process of employing intermediate 1.

The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The technical feature in the instant application common to all the groups does not provide a contribution over the prior art in the technical feature was known in the art prior to the filing of the instant application. See Kachur AV reference.

During a telephone conversation with Harry Shubin on February 12th, 2003, a provisional election was made with traverse to prosecute the invention of group I, claims 6-9, 21 and 26-35. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-20 and 22-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

III. Rejections:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

(a) Claim 21 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e.,

results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6-9 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6-9 recites the limitation "step (h)", which recites reacting 'said' persulphurated derivative obtained from step (g), in claim 6. Step (g) does not recite that a persulphurated derivative is obtained in said step, thus there is insufficient antecedent basis for this limitation in the claim. Amending step (g) to insert the phrase –to prepare a persulphurated derivative—at the end of the step is suggested to obviate the above rejections.

Claim 21 is provides for the use of compounds of formula I, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6-9, 21 and 26-35 rejected under 35 U.S.C. 102(b) as being anticipated by Koch, et al (US 5,540,908).

Applicant's claims relate to compounds of formula I, pharmaceutical compositions and methods of using the same.

(a) Claims 21, 31-34 and 9 are anticipated by Koch, et al where R2 is an alkyl substituted by halogen, the reference also teaches that in the preferred embodiment of the invention, the compound exists with a F18 isotope as instantly claimed. See col. 6, lines 4-44, particularly lines 39-43, also see col. 14, lines 18-25, also see claims 14-18.

(b) Claims 35 and 6 are also anticipated by the reference, see col. 11, lines 28-53 and lines 45-53.

(c) Claims 7-8 are anticipated by the teaching in col. 11, lines 34-45.

(d) Claims 26-30, drawn to the methods of use in detection of hypoxia is also anticipated by the reference in col. 7, lines 10-63 and claim 20.

IV. Objections:

Claims 7-9 and 21 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Instantly, claims 7-9 and 21 depend from a later occurring claim, claim 31.

Claims 6-9, 21 and 26-35 are objected to because claim 6 refers to compounds as in the figures in the drawings. For example, step (a) refers to compound 2 in figure 7. Claims need to be

complete in and of themselves, hence incorporating the structures into the claims is suggested to obviate the above objection.

V. Salutation:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea D. Small, whose telephone number is (703) 305-0811. The examiner can normally be reached on Monday-Thursday from 8:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Joseph.McKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1234

Andrea D. Small, Esq.
March 7, 2003


Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626
Technology Center 1